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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/019,114      | 10/24/2002  | Seishi Kato          | GIN-6729CPUS        | 7811             |

7590 11/01/2004

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EXAMINER

ROOKE, AGNES BEATA

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1653

DATE MAILED: 11/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/019,114

**Applicant(s)**

KATO ET AL.

**Examiner**

Agnes B Rooke

**Art Unit**

1653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-7 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

### DETAILED ACTION

Claims 1-7 are pending.

#### *Restriction*

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

**Group I, Claims 1, 2-6, drawn to a protein SEQ ID NO:1 and DNA SEQ ID NO:11.**

**Group II, Claim 1, drawn to a protein SEQ ID NO:2.**

**Group III, Claim 1, drawn to a protein SEQ ID NO:3.**

**Group IV, Claim 1, drawn to a protein SEQ ID NO:4.**

**Group V, Claim 1, drawn to a protein SEQ ID NO:5.**

**Group VI, Claim 1, drawn to a protein SEQ ID NO:6.**

**Group VII, Claim 1, drawn to a protein SEQ ID NO:7.**

**Group VIII, Claim 1, drawn to a protein SEQ ID NO:8.**

**Group IX, Claim 1, drawn to a protein SEQ ID NO:9.**

**Group X, Claim 1, drawn to a protein SEQ ID NO:10.**

**Group XI, Claims 2-6, drawn to DNA encoding SEQ ID NO:2.**

**Group XII, Claims 2-6, drawn to DNA encoding SEQ ID NO:3.**

**Group XIII, Claims 2-6, drawn to DNA encoding SEQ ID NO:4.**

**Group XIV, Claims 2-6, drawn to DNA encoding SEQ ID NO:5.**

**Group XV, Claims 2-6, drawn to DNA encoding SEQ ID NO:6.**

**Group XVI, Claims 2-6, drawn to DNA encoding SEQ ID NO:7.**

**Group XVII, Claims 2-6, drawn to DNA encoding SEQ ID NO:8.**

**Group XVIII, Claims 2-6, drawn to DNA encoding SEQ ID NO:9.**

**Group XIX, Claims 2-6, drawn to DNA encoding SEQ ID NO:10.**

**Group XX, Claim 7, drawn to Antibody against SEQ ID NO:1.**

**Group XXI, Claim 7, drawn to Antibody against SEQ ID NO:2.**

**Group XXII, Claim 7, drawn to Antibody against SEQ ID NO:3.**

**Group XXIII, Claim 7, drawn to Antibody against SEQ ID NO:4.**

**Group XXIV, Claim 7, drawn to Antibody against SEQ ID NO:5.**

**Group XXV, Claim 7, drawn to Antibody against SEQ ID NO:6.**

**Group XXVI, Claim 7, drawn to Antibody against SEQ ID NO:7.**

**Group XXVII, Claim 7, drawn to Antibody against SEQ ID NO:8.**  
**Group XXVIII, Claim 7, drawn to Antibody against SEQ ID NO:9.**  
**Group XXIX, Claim 7, drawn to Antibody against SEQ ID NO:10.**

The inventions listed as Groups I-XIX do not relate to a single inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

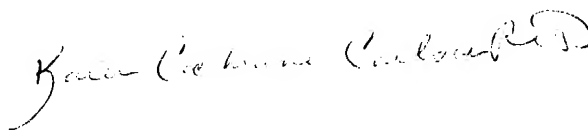
For instance, in Claim 1, a protein of SEQ ID NO:1 is disclosed as being similar to human **gastric lipase** (See page 52 of the specification), and a protein of SEQ ID NO:2 is disclosed as being similar to human **hypothetical protein** (See page 54), and further a protein of SEQ ID NO:3 is disclosed as being similar to human **glycoprotein 55** (See page 56). Therefore, the group of proteins in Claim 1, SEQ ID NO: 1-10 do not relate to a single inventive concept because their amino acid structures correspond to different products, and thus have distinct structural features. Moreover, proteins of the SEQ ID NO: 1-10 of Claim 1, have different origin since they come from different sources, and thus have distinct functions.

Therefore, the technical feature linking the inventions of Groups I-IX does not constitute a special technical feature as defined by PCT Rule 13.2.

Applicant is advised that the replay to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Agnes Rooke whose telephone number is 571-272-2055. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon Weber can be reached on 571-272-0925. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information about the PAIR system, see <http://pair-direct.uspto.gov>. or call 866-217-9197.



KAREN COCHRANE CARLSON, PH.D  
PRIMARY EXAMINER